REMARKS

Claims 1-13 are presently pending. Claims 3, 4, 7, 11 and 13 are withdrawn as being directed to non-elected subject matter.

Applicants respectfully request reconsideration of the application in view of the remarks appearing below.

Declaration of Mr. Alan Gnann

In numbered item 3 of the present Office Action, the Examining Corps of the U.S. Patent and Trademark Office discounts Mr. Gnann's Declaration (the "Declaration") that the terms "up-locking" and "down-locking" have specific meanings in the fly-fishing industry by stating that "this is not the level of the ordinary fisherman in the art. Hence the claims will be given their broadest reasonable interpretation and Pontis is relevant in rejecting the present claims." Applicants respectfully disagree.

The Examining Corps' assertion regarding the Declaration misapprehends the purpose of the Declaration and also sets forth an incorrect position on the law concerning the level of ordinary skill in the art. These issues are addressed immediately below in detail.

Purpose of the Declaration

Applicants submitted the Declaration as objective evidence that the terms "up-locking" and "down-locking" have specific ordinary and customary meanings in the technical field of fly-fishing rod design and manufacture. Indeed, as discussed below in detail, Mr. Gnann is highly qualified to make such a declaration, having presided over fly-fishing rod designers and manufacturing workers for many years.

Having been presented with this objective evidence of specific ordinary and customary meaning, it is now the burden of the Examining Corps to rebut Applicants' evidence with objective evidence of its own if it continues to consider the Declaration insufficient. This objective evidence must be more than a mere conclusory statement by the Examining Corps that it disagrees with Applicants' formal evidence.

Level of Ordinary Skill in the Art

The Examining Corps asserts that the level of ordinary skill in the art for the present invention is an "ordinary fisherman." Applicants respectfully disagree.

The present invention is directed to a cowl for a fly-fishing rod assembly. Consequently, the proper level or ordinary skill in the art for the present invention is at least someone skilled in the design and manufacture of fly-fishing rods, not the ordinary fishermen who are merely end-users of the invention.

This is readily demonstrated by the following two analogies. In a patent application directed to an improvement of an automobile, the proper level of skill by which to assess patentability and claim terminology would be the level of skill of ordinary automobile designers, not the drivers of the automobiles, i.e., not the end-users of the automobiles. To assert in this example that the requisite ordinary skill level is that of ordinary drivers would be contrary to the law on the point, as discussed below.

Automobile designers are highly trained in mechanical and other types of engineering, which are advanced fields that use terminology having precise meanings that are often unknown by common drivers. For example, many drivers are not technology-oriented and are surely ignorant of technical terms that are ordinary and customary in the field of automobile design. Consequently, to assert that patent drafters in the automobile art would be held to the standard an ordinary driver would be nonsensical.

As a more poignant example, an assertion that claim interpretation of a patent directed to a cell phone should be based on meanings ascribed and understood by ordinary cell phone users would be completely contrary to the proper law. Most cell phone users are unaware of how a cell phone works and are surely ignorant of terminology common in cell phone technology, such as programmable gain amplifiers, base-band/RF interfaces, frequency synthesizers, RF mixers, etc.

The situation in the present application is no different from the preceding examples in the automobile and cell phone arts. That is, the level of skill of the ordinary end users of the fly-fishing rods improved by the present invention is not the proper measure by which to judge whether or not claim terminology has a particular ordinary and customary meaning in the

relevant art. Like the end users of automobiles and cell phones, ordinary fisherman are frequently unfamiliar with technical terms used in the design and manufacture of the products they use.

In contrast, the proper level of ordinary skill in the art in the present case is the level of skill of an ordinary fishing rod designer. Like the automobile designers mentioned above, an ordinary designer of fishing rods is skilled in mechanical design, materials science, and other technical areas necessary for the design of marketable (i.e., quality) fishing equipment. It can hardly be said that an "ordinary fisherman" possesses the skill set necessary to make quality fishing equipment. As discussed below, the fact that the Examining Corps may consider the present invention to be simplistic does not change the fact that the fishing rod designers are the bases by which to assess ordinary skill in the art.

Indeed, many court decisions that have considered the issue of ordinary skill in the art have held that the proper level of skill in an art is that of "persons with long experience in the field." Chisum on Patents § 5.03[4][e]. For example, relative to the automobile example presented above, in Howe v. General Motors Corp., the Seventh Circuit stated that "the level of ordinary skill in the field of designing automobile bodies, including hinges, was that of engineers of substantial training, and specialized skill." 401 F.2d 73, 74, 158 USPQ 522, 526 (7th Cir. 1968), *cert. denied*, 396 U.S. 919, *reh'g denied*, 394 U.S. 1025 (1969). In this case, even though one may consider hinges to be relatively simplistic, the court nevertheless found that the well educated automobile designers were the bases by which to judge ordinary skill in the art.

More on point with Applicants' position that the level of ordinary skill should be assessed relative to a designer of a product, rather than its end users, in STX, Inc. v. Brine, the court stated in the context of lacrosse sticks:

> I am persuaded that, as a matter of law, an artisan of ordinary skill in the art of designing lacrosse heads ('strung racquet art') is a skilled designer who has either played lacrosse or, in the alternative, although not having played the game, is knowledgeable about how accomplished players use a lacrosse stick, and what performance features such players expect from their lacrosse sticks in the course of playing the sport on the collegiate or professional level.

37 F.Supp. 2d 740, 750-51, 50 USPQ2d 1236, 1243-44 (D. Md. 1999), aff'd, 211 F.3d 588, 54 USPQ2d 1347 (Fed. Cir. 2000) (emphasis added). This passage is particularly instructive in the

present case because the court acknowledges that ordinary-skilled artisans, i.e., designers, do not even have to be end users of the products they design. Clearly, case law shows that end users of products are not the proper people against which to judge the level or ordinary skill in the art. Therefore, the Examining Corps is incorrect in asserting that ordinary fishermen are the bases for assessing the meaning of claim terminology.

Mr. Gnann is an Expert

Mr. Gnann is an incontrovertible expert in the field of fly fishing. Moreover, Mr. Gnann is in a well-informed position to make a declaration that the terms "up-locking" and "down-locking" indeed have ordinary and well-known meanings to those having ordinary skill in the art. As discussed above, the proper level of skill in the art for the present invention is the level of skill of ordinary professional designers of fishing rods. Mr. Gnann is president of a fishing equipment manufacturer and has worked intimately with many professional fly-fishing rod designers for years and is very familiar with the terminology these designers use, including the terms "up-locking" and "down-locking". In the Declaration, Mr. Gnann declares, under penalty of giving a false statement, that the terms "uplocking" and "downlocking" are used in the industry in a very specific consistent and precise manner. In other words, Mr. Gnann is Declaring that fly-fishing rod designers, i.e., the people having ordinary skill in the art, know that the terms "uplocking" and "downlocking" have the specific meanings expressed in the Declaration and use these terms to convey such meanings to others having ordinary skill in the art during the normal course of their work.

The Pontis Patent Unequivocally Does Not Show an Up-Locking Reel Lock

Since the ordinary and customary meanings of the terms "up-locking" and "down-locking" are as Applicants have been asserting all along during prosecution of the present application, it should be manifestly clear to the Examining Corps that Pontis does not disclose or even suggest an up-locking reel lock. The bulbous portion of the Pontis handle that extends up the rod extends in a direction completely opposite a cowl of the present claims and provides a much different function than the function of the present invention. Further details regarding the Pontis patent are discussed below in connection with the rebuttals to the claim rejections.

Rejection Under 35 U.S.C. § 103

The Examiner has again rejected claims 1-13 under 35 U.S.C. § 103 as being obvious in view of Japan publication number 10075691 to Sugamata, U.S. Patent No. Des. 131,494 to Pontis and U.S. Patent No. 5,048,223 to Yamamoto et al., stating that Sugamata discloses a fishing rod having all of the limitations of these claims except a semi-cylindrical cowl forming a continuation of a rod handle and a sleeve overlapping a reel seat body. The Examiner then asserts that Pontis and Yamamoto et al. disclose these features and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide Sugamata's rod with the cowl and sleeve disclosed by Pontis and Yamamoto et al. Applicants respectfully disagree.

With the well-known ordinary and customary meanings of the terms "up-locking," "down-locking," "up-locking reel lock," and "down-locking reel lock" in mind, Applicants respectfully assert that claims 1-13 are not obvious in view of the cited combination for at least the reasons discussed below.

Sugamata discloses a down-locking fishing rod (1), i.e., a fishing rod having a grip (7) and a reel (R) that is locked in place on a reel seat (generally, 9) using a nut (not labeled) that engages threads (not labeled) adjacent the grip, which is located distal from the butt end of the rod. To secure the reel, the nut is turned so that it moves relative to the reel seat in a direction toward the butt end of the rod (i.e., toward the left in the figure the Examiner provided in the present Office Action). This nut forms part of the down-locking reel lock. It is noted that the terms "down" and "up" have particular meanings well known in the art. "Down" refers to the direction toward the butt end of the rod and "up" refers to the direction away from the butt end. The reel seat is located down the rod from the grip.

Pontis discloses an ergonomic grip for a fishing rod. The grip includes contours that conformally receive various portions of a user's hand. A reel seat is located up the rod from the grip. The Pontis fishing rod is essentially a down-locking rod in which the reel (not shown) is secured to the rod by turning a knob (unlabeled) located at the upper end of the reel seat so that a lock (not labeled) moves downward relative to the rod. The grip includes a bulbous portion that appears to be provided to accommodate the thumb of a user during use.

Yamamoto et al. disclose a down-locking fishing rod having a handle that consists of a first grip member (13) located proximate the butt end of the rod and a second grip member (14) located up the rod from the first grip member. Regarding the down-locking nature of the fishing rod, note the threads (12c) in FIG. 2. The reel seat (reel mounting member 12) is located up the rod from the first grip member and down the rod from the second grip member. The first grip member has a portion (13') that extends over the reel seat opposite the reel and appears to be provided to accommodate the upper region (relative to the up direction of the rod) of a user's palm during use.

In contrast to each of the Sugamata, Pontis and Yamamoto et al. fishing rods, and any combination thereof, claims 1-13, as previously amended, are directed to a cowl and fishing rod handle particularly configured for an up-locking fishing rod, wherein the cowl comprises a semi-cylindrical body that extends down the rod, i.e., toward the butt end of the rod. First, not one of the Sugamata, Pontis, and Yamamoto et al. fishing rods is an up-locking rod. Therefore, none of these fishing rods include an up-locking reel lock as required by each of amended independent claims 1, 5, and 9.

Second, none of the Sugamata, Pontis, and Yamamoto et al. fishing rods have a cowl that extends down the rod, as required by each of amended independent claims 1, 5, and 9. The Sugamata rod does not include any structure that could be considered a cowl, let alone a cowl extending down the rod. The Pontis rod discloses a bulbous portion that extends up the rod, i.e., away from the butt end of the rod. The Yamamoto et al. patent discloses a first grip member having a portion that extends up the rod, again, away from the butt end of the rod. Therefore, even if one were to use either the Pontis or Yamamoto et al. grip with the Sugamata rod, the extending portions would extend up the rod, not down the rod as is the case with the present invention.

In this connection, Applicants further assert that the Pontis and Yamamoto et al. grips are specifically designed to be grips extending away from the butt end of the rod in order to accommodate portions of a user's hand located distal from the butt. It simply would not make sense to orient them the opposite way so that the extensions extend down the rod since the respective rods are not designed to be gripped in this manner. In contrast, the cowl of the present

invention is designed to engage the portion of a user's hand proximate the butt end of the rod. Consequently, Applicants assert that the only motivation to change the orientations of the Pontis and Yamamoto et al. grips is hindsight motivation based on the present claims. Of course, this sort of motivation is improper in formulating obviousness-type rejections.

Third, Applicants assert that those skilled in the art would not be motivated to make the combination asserted by the Examiner. This is so because the Sugamata publication is directed to a fishing rod having a telescope attached thereto opposite the reel. Locating the telescope as shown obviates the need and, more generally, eliminates the possibility of having any sort of extension located over the reel seat opposite the reel, as is the case with the cowl of the present claims. This is so because the Sugamata telescope would interfere with a user attempting to grip the fishing rod in the manner contemplated by the present invention. Therefore, there is no need for the cowl of the present invention on the Sugamata rod. Consequently, Applicants assert that someone skilled in the art simply would not be motivated to make the present combination. No support has been provided for the assertion that knowledge generally available to one of ordinary skill in the art provides a teaching, suggestion or motivation to combine references. Therefore, the combination is improper.

For at least the foregoing reasons, Applicants assert that independent claim 1, 5, and 9, and claims 2-4, 6-8, and 10-13 that depend therefrom, are not obvious in view of the asserted combination. Therefore, Applicants respectfully request that the Examiner withdraw the present rejection.

Additional Comments on Examiner's Rebuttal in Item 3 of the Office Action

In numbered item 3 of the present Office Action, the Examiner states:

> The examiner would further like to point out that the present invention is concerned with a supplemental handle for covering part of the reel seat and that one skilled in the art would look at all fishing rods that have reel seats and reels when considering a supplemental handle since a user's hand could become uncomfortable with casting, spinning, spin-casting and fly fishing rods due to the nature of the reel seat.

It is interesting to note that the U.S. Patent and Trademark Office deemed the subject matter of the parent application of this application to be patentable. See U.S. Patent No. 6,629,382 ("the

'382 patent"). Generally, the claims of the '382 patent are directed to a fishing rod assembly that includes an up-locking fishing rod that includes the cowl of the present claims. It is particularly interesting to note that the Examining Corps considered the Pontis patent during prosecution of the claims of the '382 patent and considered those claims to be patentable over the Pontis patent.

Using the Examiner's reasoning, it appears that the Examining Corps should not have found the claims in the parent application to be patentable. However, it did. The claims of the present application differ in large part from the issued claims in that the present claims are directed particularly to the cowl, whereas the issued claims are directed to the cowl in combination with an up-locking rod. As the Examiner points out, the present inventors did not invent up-locking rods. Therefore, it appears that patentability in the parent application was based on the cowl, which is now being claimed without positively reciting the attendant rod in the bodies of the claims. That said, although the present claims are directed to the cowl, the scope of the claims are constrained by structure recited in the preamble, which makes the present claims of substantially the same patentable scope as the issued claims. Applicants respectfully submit that the present claims are allowable over the prior art of record for the same reasons that the claims of the '382 patent are patentable over the prior art considered during the prosecution of those claims that, again, included the Pontis patent.

Regarding the Examiner's assertion that the level of hindsight reconstruction used in the present rejection does not exceed the level sanctioned by the courts, Applicants respectfully disagree. While Applicants recognize that any obviousness analysis necessarily requires a certain level of hindsight reconstruction, Applicants assert that in the present case the amount of hindsight used exceeds the sanctioned amount. For example, not one of the references cited by the Examiner or discovered by the Examiner disclose or even suggest a cowl of the present invention. Indeed, up-locking fishing rods have existed for many years. However, until the present invention, no one to the Examiner's knowledge or Applicants' knowledge had disclosed such a cowl. Surely, if the present invention were as obvious as the Examiner suggests, someone would have implemented such a cowl long ago and the Examining Corps would not have deemed the claims of '382 patent to be patentable. However, neither of these things is true.

Regarding the Examiner's statement with respect to the Sugamata reference that he is not clear why the presence of the telescope obviates the need of having a down-rod extension on the grip (7), Applicants assert that the size and location of the telescope place the normal gripping region of the grip forward of the up-rod end of the telescope. Consequently, during any normal-usage gripping of the grip, the user's hand is positioned completely forward of the up-rod end of the telescope.

Indeed, this fact appears to have been considered by the designer of the Sugamata grip as evidenced by the configuration of the Sugamata grip. Note particularly that the down-rod end of the grip (i.e., the end of the grip proximate the telescope) is flared outward relative to the midsection of the grip and that the up-rod end of the grip is tapered inward relative to the midsection of the grip. Applicants submit that the flared end is designed as a palm rest or stop that a user can rest the palm of his hand against during normal gripping. The inwardly tapered opposite end is where a user can place his thumb and forefinger during normal gripping. The midsection of the grip is where the bulk of the gripping occurs.

To assert that someone having ordinary skill in the art would be motivated to add a down-rod extension to the Sugamata grip would be to ignore the practicality of the matter. As the designer of the Sugamata grip appears to have recognized, and acknowledged through the configuration of the grip, the telescope is an interference that relegates a user to grip (under normal usage) the grip forward of the up-rod end of the telescope. Indeed, the designer of the Sugamata grip has made the grip ergonomic to do so.

In addition, the Sugamata rod is a down-locking rod, which means that the threaded locking ring is proximate the down-rod end of the grip. An extension of the grip in the manner asserted by the Examiner would interfere with the proper operation of the locking ring and, thus, would not be attempted by a skilled artisan. Consequently, those skilled in the art would simply not be motivated to make the changes asserted by the Examiner.

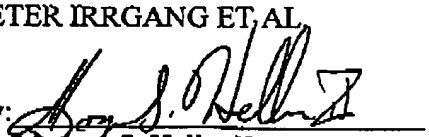
Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-13, as previously amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance

is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,

PETER IRRGANG ET AL

By: 

Morgan S. Heller II
Registration No.: 44,756
Down Rachlin Martin PLLC
Attorneys for Applicants
Tel: (802) 863-2375

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